

Appl. No.: 09/875,237
Group Art Unit: 1714
Applicants' Reply to Paper No. 6

REMARKS

Claims 1-30 are currently pending in the present application.

In Paper No. 6, the Examiner rejects claims 1-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,399,741 of Fry, *et al.* (hereinafter referred to as "Fry" or "the Fry reference"). The Examiner contends that while the conflicting claims are not identical, they are not patentably distinct because "the ordinary practitioner in this art would be able to determine that a color stabilizing effective amount of the number of reactive amino functionalities is between 20% and 60%." (See, Paper No. 6, p.2). The Examiner also contends that claim 1 of the Fry reference discloses that a color stabilizing effective amount of the number of reactive amino functionalities have a substituent compound independently selected from the group consisting of carboxylic acids and amine protecting compounds. The Examiner then incorrectly states that "Applicant[s'] claims require that 20% to 60% of the reactive amino functionalities have a substituent compound independently selected from the group consisting of carboxylic acids *and amine protecting compounds . . .*" (See, *id.* at p. 2 (*emphasis added*)). The Examiner argues that "the ordinary practitioner" would have been able to determine that a color stabilizing effective amount is from between 20% and 60% of the reactive amino functionalities. Finally, the Examiner argues that the selection of particular carboxylic acids would also have been obvious. On these bases, the Examiner argues that the instant claims would have been obvious over claims 1-42 of the Fry reference.

Applicants strenuously, but respectfully traverse the Examiner's rejection and the arguments and contentions set forth in support thereof for the following reasons. First, the Examiner has mischaracterized the claimed invention. Second, the Fry reference fails to contain disclosure, either explicit or implicit, which satisfies the criteria necessary to establish *prima facie* obviousness, or in this case, sustain a rejection based upon obviousness-type double patenting.

The Examiner has stated that "Applicant[s'] claims require that 20% to 60% of the reactive amino functionalities have a substituent compound independently selected from the

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group consisting of carboxylic acids *and amine protecting compounds . . .*" (*See, id.* at p. 2 (*emphasis added*)). THIS IS INCORRECT. Applicants' claimed invention is directed to polymer derivatives comprising a polyalkyleneimine backbone having a number of reactive amino functionalities, each reactive amino functionality having at least one reactive hydrogen atom, wherein from about 20% to about 60% of the number of reactive amino functionalities have a substituent-compound substituted in place of the at least one reactive hydrogen atom, each substituent-compound independently selected from the group consisting of carboxylic acids having from about 14 to about 20 carbon atoms. (*See, Applicants' claim 1 (emphasis added)*).

Clearly, the "from about 20% to about 60% of the number of reactive amino functionalities" which are substituted in accordance with the claimed invention bear a substituent selected from the group consisting of *carboxylic acids* having from about 14 to about 20 carbon atoms, *not* a substituent selected from the group consisting of all carboxylic acids *and amine-protecting groups*.

With respect to the patentable distinction of the claimed invention, Applicants respectfully disagree with the Examiner's contentions, arguments, and conclusions. The Examiner has argued that one of ordinary skill in the art would have been able to determine that a color stabilizing effective amount is from between 20% and 60% of the reactive amino functionalities. However, the Fry reference specifically discloses that, "a 'color stabilizing-effective amount', means an amount which is *at least* about 60-65% of the total number of reactive amino functionalities present in a given polyalkyleneimine backbone." (*See, Fry, col. 4, lines 39-43 (emphasis added)*).

Accordingly, one of ordinary skill in the art would have to ignore the express teachings of Fry. It is difficult to imagine one of ordinary skill in the art choosing an amount of amino-group substitution of from about 20 to about 60% when Fry teaches *at least* about 60-65%. Moreover, Fry discloses substitution with groups selected from carboxylic acids AND amine-protecting groups. There is no teaching or suggestion within the disclosure of Fry which would motivate one of ordinary skill in the art to select entirely from the group consisting of carboxylic acids.

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Applicants note that the Examiner has repeatedly stated that one of ordinary skill in the art would recognize that "from 20% to 60%" is "a color stabilizing-effective amount" and that this somehow obviates the presently claimed invention. The current claims do not reference a color stabilizing effective amount. This is language from the Fry reference, which specifically defines this amount differently than that which is currently claimed. Moreover, the substituents are not the same.

Accordingly, Applicants submit that the claimed invention is patentably distinct from the claims of the Fry reference and that no improper timewise extension of the right to exclude would result from the patenting of the instant claims.

In view of the comments set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration, withdrawal of the rejection and a Notice of Allowance for all pending claims are respectfully requested.

Respectfully submitted,

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